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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT PAPER NUMBER

1772

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/214,971

Applicant(s)

VALENTE, GABRIELE

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004 and 13 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8,9,13,14,18,19 and 24-56 is/are pending in the application.
- 4a) Of the above claim(s) 37-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8,9,13,14,18,19 and 24-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 8/2/04.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

RESPONSE TO AMENDMENT

In view of the Interview with Applicant on August 2, 2004, the notice of non-compliance mailed July 9, 2004 is vacated and an action on its merits based on the amendment filed April 22, 2004 follows.

1. Claims 8, 9, 13, 14, 18, 19, 24-56 are pending in the application, claims 37-56 are withdrawn from consideration. Claims 1-7, 10-12, 15-17, 20-23 have been.
2. Amendments to the claims, filed on April 22, 2004 and August 13, 2003, have been entered in the above-identified application.

WITHDRAWN REJECTIONS

3. The 35 U.S.C. §112, first paragraph rejections of claims 8, 13, 18, 31, 32 and 33, made of record in paper #32, mailed December 3, 2003, page 3, paragraph #5 have been withdrawn due to Applicant's amendments in the responses filed August 13, 2003 and April 22, 2004.
4. The 35 U.S.C. §112, first paragraph rejections of claims 13 and 32 made of record in paper #32, pages 3-4, paragraph #6 have been withdrawn due to Applicant's amendments in the responses filed August 13, 2003 and April 22, 2004.
5. The 35 U.S.C. §103 rejections made of record in paper #32, pages 4-8, paragraphs #7-11 has been withdrawn due to Applicant's amendment the responses filed August 13, 2003 and April 22, 2004.

REJECTIONS

6. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 8, 9, 24-31 and 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case amended claims 8 and 31 contain(s) the negative limitation "to provide a composite with only two materials." The specification does not disclose that the extra layer are excluded from the composite, therefore this limitation is considered new matter. The specification specifically states that extra layers such as dyestuff layers, wool layers, nets and adhesive can be part of the composite (*specification page 4*).

Any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. MPEP § 2173.05(i)

The new matter should be deleted.

9. Claims 8, 9, 13, 14, 18, 19, 24-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites "a supporting material in the form of sheet or roll constituted by and ..." which is unclear and renders the claims vague and indefinite. It is unclear what the supporting material is constituted by.

Claim 13 recites "a supporting material ... constituted *by one of the following materials*: natural leather, a covering surface layer including a polyethylene film" which is unclear and renders the claim indefinite. The claim is confusing since claim language claims a composite that only constitutes a supporting material, which is either natural leather or a polyethylene film.

Claim 18 recites "a supporting material ... constituted *by one of the following materials*: natural leather, a covering surface layer including a polyethylene film" which is unclear and renders the claim indefinite. The claim is confusing since claim language claims a composite that only constitutes a supporting material, which is either natural leather or a polyethylene film. Furthermore, since the composite material is either the natural leather or the polyethylene film it is unclear how "the natural leather being (is) directly coupled to the (polyethylene) film."

Claim 31 recites "a supporting material ... constituted by a mixture of a regenerated natural leather material" and then later recites "the materials being the natural leather and the polyethylene film," which is unclear and renders the claim vague and indefinite. It is unclear from the claim language whether the composite comprises a regenerated leather or a natural leather layer.

Claim 32 recites “a supporting material ... constituted *by one of the following materials*: regenerated leather, a covering surface layer including a polyethylene film” which is unclear and renders the claim indefinite. The claim is confusing since claim language claims a composite that only constitutes a supporting material, which is either regenerated leather or a polyethylene film.

Claim 33 recites “a supporting material ... constituted *by one of the following materials*: regenerated leather, a covering surface layer including a polyethylene film” which is unclear and renders the claim indefinite. The claim is confusing since claim language claims a composite that only constitutes a supporting material, which is either regenerated leather or a polyethylene film. Furthermore, since the composite material is either the regenerated leather or the polyethylene film it is unclear how “the regenerated leather being (is) directly coupled to the (polyethylene) film.”

Claim Rejections - 35 USC § 102

10. Claims 8, 9, 13, 14, 18, 19, 24-27, 30, 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirsch (U.S. Patent No. 4,849,145).

Regarding Applicant's claim 8, Hirsch discloses a method of using a composite material (*material having at least two layers, title*) comprising a supporting material in the form of a sheet of roll constituted by (*strip of leather, col. 5, line 31*) and a covering layer including a film of polyethylene (*layer of synthetic resin, i.e. polyethylene, col. 5, lines 26-28*), to provide a composite material of only two materials (*figure 1*). The materials being natural leather (*col. 5, line 31*) and the polyethylene film (*col. 5, lines 26-28*).

The composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases and/or briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements, since the reference discloses a great variety of different articles can be produced with the material such as small leather goods, suitcases, etc. (*col. 4, line 66 through col. 5, line 4*).

Furthermore, the method of using the composite material includes the step of forming the material into a shape to produce at least one of the products, since the reference discloses using the material to make three-dimensional articles by sewing, gluing, welding, and the like (*col. 1, lines 25-28*).

Regarding Applicant's claim 9, Hirsch discloses that the method of using the composite includes the step of cutting the composite material to form the product, since the reference discloses to precutting the strips during formation of the product (*col. 4, lines 54-65*).

Regarding Applicant's claim 13, Hirsch discloses a method of using a composite material (*material having at least two layers, title*) comprising a supporting material (*strip of leather, col. 5, line 31*) in the form of a sheet of roll constituted by one of the following materials: natural leather (*strip of leather, col. 5, line 31*) or a covering surface layer including a polyethylene film (*layer of synthetic resin, i.e. polyethylene, col. 5, lines 26-28*).

The composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases and/or briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements, since the reference discloses a great variety of different articles can be produced with the material such as small leather goods, suitcases, etc. (*col. 4, line 66 through col. 5, line 4*).

Furthermore, the method of using the composite material includes the step of forming the material into a shape to produce at least one of the products, since the reference discloses using the material to make three-dimensional articles by sewing, gluing, welding, and the like (*col. 1, lines 25-28*).

Regarding Applicant's claim 14, Hirsch discloses that the method of using the composite includes the step of cutting the composite material to form the product, since the reference discloses to precutting the strips during formation of the product (*col. 4, lines 54-65*).

Regarding Applicant's claim 18, Hirsch discloses a method of using a composite material (*material having at least two layers, title*) comprising a supporting material (*strip of leather, col. 5, line 31*) in the form of a sheet of roll constituted by one of the following materials: natural leather (*strip of leather, col. 5, line 31*) or a covering surface layer including a polyethylene film (*layer of synthetic resin, i.e. polyethylene, col. 5, lines 26-28*). The natural leather being directly coupled to the film (*figure 1 and col. 4, lines 21-65*).

The composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases and/or briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements, since the reference discloses a great variety of different articles can be produced with the material such as small leather goods, suitcases, etc. (*col. 4, line 66 through col. 5, line 4*).

Furthermore, the method of using the composite material includes the step of forming the material into a shape to produce at least one of the products, since the reference discloses using the material to make three-dimensional articles by sewing, gluing, welding, and the like (*col. 1, lines 25-28*).

Regarding Applicant's claim 19, Hirsch discloses that the method of using the composite includes the step of cutting the composite material to form the product, since the reference discloses to precutting the strips during formation of the product (*col. 4, lines 54-65*).

Applicant's claims 24-27 claim different ways of bonding the film layer to the leather. The method of forming the product is not germane to the issue of patentability of the method of using the product or the product itself. The determination of patentability for a method of using a product claim is based on the product itself and the method of using the product and not on the method of production. The method of forming the product is not germane to the issue of patentability of the method of using a product, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art MPEP §2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Hirsch discloses a strip of natural leather bonded to a polyethylene film (*col. 5, lines 21-65*).

Regarding Applicant's claim 30, Hirsch discloses the composite includes forming a series of perforations (holes, *col. 6, lines 27-30*).

Regarding Applicant's claim 32, Hirsch discloses a method of using a composite material (*material having at least two layers, title*) comprising a supporting material in the form of a sheet of roll constituted by one of the following materials: regenerated leather *or* a covering surface layer including a polyethylene film (*layer of synthetic resin, i.e. polyethylene, col. 5, lines 26-28*).

The composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases and/or

briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements, since the reference discloses a great variety of different articles can be produced with the material such as small leather goods, suitcases, etc. (*col. 4, line 66 through col. 5, line 4*).

Furthermore, the method of using the composite material includes the step of forming the material into a shape to produce at least one of the products, since the reference discloses using the material to make three-dimensional articles by sewing, gluing, welding, and the like (*col. 1, lines 25-28*).

Regarding Applicant's claim 33, Hirsch discloses a method of using a composite material (*material having at least two layers, title*) comprising a supporting material in the form of a sheet of roll constituted by one of the following materials: regenerated leather *or* a covering surface layer including a polyethylene film (*layer of synthetic resin, i.e. polyethylene, col. 5, lines 26-28*).

The composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases and/or briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements, since the reference discloses a great variety of different articles can be produced with the material such as small leather goods, suitcases, etc. (*col. 4, line 66 through col. 5, line 4*).

Furthermore, the method of using the composite material includes the step of forming the material into a shape to produce at least one of the products, since the reference discloses using the material to make three-dimensional articles by sewing, gluing, welding, and the like (*col. 1, lines 25-28*).

11. Claims 8, 9, 13, 14, 18, 19, 24-27, 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Hofferbert (U.S. Patent No. 2,823,157).

Regarding Applicant's claim 8, Hofferbert discloses a method of using a composite material (*pad cover, col. 2, line 53*) comprising a supporting material in the form of a sheet of roll constituted by (*layer of leather, col. 2, line 55*) and a covering layer including a film of polyethylene (*layer of polyethylene, col. 2, line 56*), to provide a composite material of only two materials (*figure 3*). The materials being natural leather (*col. 2, line 55*) and the polyethylene film (*col. 2, line 56*).

The composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases and/or briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements, since the reference discloses the pads are for soles of shoes and pad covers (*col. 1, lines 15-19*).

Furthermore, the method of using the composite material includes the step of forming the material into a shape to produce at least one of the products (*Example A*).

Regarding Applicant's claim 9, Hofferbert discloses that the method of using the composite includes the step of cutting the composite material to form the product (*col. 5, lines 42-43*).

Regarding Applicant's claim 13, Hofferbert discloses a method of using a composite material (*pad cover, col. 2, line 53*) comprising a supporting material (*layer of leather, col. 2, line 55*) in the form of a sheet of roll constituted by one of the following materials: natural leather (*col. 2, line 55*) or a covering surface layer including a polyethylene film (*layer of polyethylene, col. 2, line 56*).

The composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases and/or briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements, since the reference discloses the pads are for soles of shoes and pad covers (*col. 1, lines 15-19*).

Furthermore, the method of using the composite material includes the step of forming the material into a shape to produce at least one of the products (*Example A*).

Regarding Applicant's claim 14, Hofferbert discloses that the method of using the composite includes the step of cutting the composite material to form the product, since the reference discloses to precutting the strips during formation of the product (*col. 5, lines 42-43*).

Regarding Applicant's claim 18, Hofferbert discloses a method of using a composite material (*pad cover, col. 2, line 53*) comprising a supporting material (*layer of leather, col. 2, line 55*) in the form of a sheet of roll constituted by one of the following materials: natural leather (*col. 2, line 55*) or a covering surface layer including a polyethylene film (*layer of polyethylene, col. 2, line 56*). The natural leather being directly coupled to the film (*figure 3 and col. 2, line 70 through col. 3, line 5*).

The composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases and/or briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements, since the reference discloses the pads are for soles of shoes and pad covers (*col. 1, lines 15-19*).

Furthermore, the method of using the composite material includes the step of forming the material into a shape to produce at least one of the products (*Example A*).

Regarding Applicant's claim 19, Hofferbert discloses that the method of using the composite includes the step of cutting the composite material to form the product, since the reference discloses to precutting the strips during formation of the product (*col. 5, lines 42-43*).

Applicant's claims 24-27 claim different ways of bonding the film layer to the leather. The method of forming the product is not germane to the issue of patentability of the method of using the product or the product itself. The determination of patentability for a method of using a product claim is based on the product itself and the method of using the product and not on the method of production. The method of forming the product is not germane to the issue of patentability of the method of using a product, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art MPEP §2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Hofferbert discloses a strip of natural leather bonded to a polyethylene film (*col. 2, line 70 through col. 3, line 5*).

Regarding Applicant's claim 32, Hofferbert discloses a method of using a composite material (*pad cover, col. 2, line 53*) comprising a supporting material in the form of a sheet of roll constituted by one of the following materials: regenerated leather *or* a covering surface layer including a polyethylene film (*layer polyethylene, col. 2, line 56*).

The composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases and/or briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements, since the reference discloses the pads are for soles of shoes and pad covers (*col. 1, lines 15-19*).

Furthermore, the method of using the composite material includes the step of forming the material into a shape to produce at least one of the products (*Example A*).

Regarding Applicant's claim 33, Hofferbert discloses a method of using a composite material (*pad cover, col. 2, line 53*) comprising a supporting material in the form of a sheet of roll constituted by one of the following materials: regenerated leather *or* a covering surface layer including a polyethylene film (*layer of polyethylene, col. 2, line 56*).

The composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases and/or briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements, since the reference discloses the pads are for soles of shoes and pad covers (*col. 1, lines 15-19*).

Furthermore, the method of using the composite material includes the step of forming the material into a shape to produce at least one of the products (*Example A*).

12. Claims 8, 9, 13, 14, 18, 19, 24-27, 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Sutton (U.S. Patent No. 3,547,753).

Regarding Applicant's claim 8, Sutton discloses a method of using a composite material (*laminate, col. 1, line 12*) comprising a supporting material in the form of a sheet of roll constituted by (*substrate, i.e. leather, col. 2, lines 30-35*) and a covering layer including a film of polyethylene (*thermoplastic film, i.e. polyethylene, col. 2, lines 29-30 and col. 3, line 15*), to provide a composite material of only two materials (*figures 2 and 3*). The materials being natural leather (*col. 2, line 35*) and the polyethylene film (*col. 3, line 15*).

The limitation "the composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases

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and/or briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements, since the reference discloses the pads are for soles of shoes and pad covers” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the method of using the composite or the structure of the product is concerned. In method of using claims, a claimed intended use must result in a *difference method of using* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. In the case, there does not appear to be a difference between the prior art method of using and structure and the method of using and structure resulting from the claimed intended use because Sutton discloses natural leather bonded to a polyethylene film (*col. 2, line 35 and col. 3, line 15*).

The limitation “including the step of forming the material into a shape to produce at least one of the products” is a method limitation. The method of forming the product is not germane to the issue of patentability of the method of using the product or the product itself. The determination of patentability for a method of using a product claim is based on the product itself and the method of using the product and not on the method of production. The method of forming the product is not germane to the issue of patentability of the method of using a product, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art MPEP §2113. Furthermore, there does not appear to be a difference between the prior art method of using and structure and the method of using and structure resulting from the claimed intended use because Sutton discloses natural leather bonded to a polyethylene film (*col. 2, line 35 and col. 3, line 15*).

Regarding Applicant’s claim 9, the limitation “including the step of cutting the composite material to form the product” is a method limitation. The method of forming the product is not

germane to the issue of patentability of the method of using the product or the product itself.

The determination of patentability for a method of using a product claim is based on the product itself and the method of using the product and not on the method of production. The method of forming the product is not germane to the issue of patentability of the method of using a product, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art MPEP §2113. Furthermore, there does not appear to be a difference between the prior art method of using and structure and the method of using and structure resulting from the claimed intended use because Sutton discloses natural leather bonded to a polyethylene film (*col. 2, line 35 and col. 3, line 15*).

Regarding Applicant's claim 13, Sutton discloses a method of using a composite material (*laminate, col. 1, line 12*) comprising a supporting material (*substrate, i.e. leather, col. 2, lines 30-35*) in the form of a sheet of roll constituted by one of the following materials: natural leather (*col. 2, line 35*) **or** a covering surface layer including a polyethylene film (*thermoplastic film, i.e. polyethylene, col. 2, lines 29-30 and col. 3, line*).

The limitation "the composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases and/or briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements, since the reference discloses the pads are for soles of shoes and pad covers" is deemed to be a statement with regard to the intended use and is not further limiting in so far as the method of using the composite or the structure of the product is concerned. In method of using claims, a claimed intended use must result in a ***difference method of using*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. In

the case, there does not appear to be a difference between the prior art method of using and structure and the method of using and structure resulting from the claimed intended use because Sutton discloses natural leather bonded to a polyethylene film (*col. 2, line 35 and col. 3, line 15*).

The limitation “including the step of forming the material into a shape to produce at least one of the products” is a method limitation. The method of forming the product is not germane to the issue of patentability of the method of using the product or the product itself. The determination of patentability for a method of using a product claim is based on the product itself and the method of using the product and not on the method of production. The method of forming the product is not germane to the issue of patentability of the method of using a product, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art MPEP §2113. Furthermore, there does not appear to be a difference between the prior art method of using and structure and the method of using and structure resulting from the claimed intended use because Sutton discloses natural leather bonded to a polyethylene film (*col. 2, line 35 and col. 3, line 15*).

Regarding Applicant’s claim 14, the limitation “including the step of cutting the composite material to form the product” is a method limitation. The method of forming the product is not germane to the issue of patentability of the method of using the product or the product itself. The determination of patentability for a method of using a product claim is based on the product itself and the method of using the product and not on the method of production. The method of forming the product is not germane to the issue of patentability of the method of using a product, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art MPEP §2113.

Furthermore, there does not appear to be a difference between the prior art method of using and structure and the method of using and structure resulting from the claimed intended use because Sutton discloses natural leather bonded to a polyethylene film (*col. 2, line 35 and col. 3, line 15*).

Regarding Applicant's claim 18, Hofferbert discloses a method of using a composite material (*laminate, col. 1, line 12*) comprising a supporting material (*substrate, i.e. leather, col. 2, lines 30-35*) in the form of a sheet of roll constituted by one of the following materials: natural leather (*col. 2, line 35*) **or** a covering surface layer including a polyethylene film (*thermoplastic film, i.e. polyethylene, col. 2, lines 29-30 and col. 3, line 15*). The natural leather being directly coupled to the film (*figures 2 and 3*).

The limitation "the composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases and/or briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements, since the reference discloses the pads are for soles of shoes and pad covers" is deemed to be a statement with regard to the intended use and is not further limiting in so far as the method of using the composite or the structure of the product is concerned. In method of using claims, a claimed intended use must result in a ***difference method of using*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. In the case, there does not appear to be a difference between the prior art method of using and structure and the method of using and structure resulting from the claimed intended use because Sutton discloses natural leather bonded to a polyethylene film (*col. 2, line 35 and col. 3, line 15*).

The limitation "including the step of forming the material into a shape to produce at least one of the products" is a method limitation. The method of forming the product is not germane

to the issue of patentability of the method of using the product or the product itself. The determination of patentability for a method of using a product claim is based on the product itself and the method of using the product and not on the method of production. The method of forming the product is not germane to the issue of patentability of the method of using a product, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art MPEP §2113. Furthermore, there does not appear to be a difference between the prior art method of using and structure and the method of using and structure resulting from the claimed intended use because Sutton discloses natural leather bonded to a polyethylene film (*col. 2, line 35 and col. 3, line 15*).

Regarding Applicant's claim 19, the limitation "including the step of cutting the composite material to form the product" is a method limitation. The method of forming the product is not germane to the issue of patentability of the method of using the product or the product itself. The determination of patentability for a method of using a product claim is based on the product itself and the method of using the product and not on the method of production. The method of forming the product is not germane to the issue of patentability of the method of using a product, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art MPEP §2113. Furthermore, there does not appear to be a difference between the prior art method of using and structure and the method of using and structure resulting from the claimed intended use because Sutton discloses natural leather bonded to a polyethylene film (*col. 2, line 35 and col. 3, line 15*).

Applicant's claims 24-27 claim different ways of bonding the film layer to the leather. The method of forming the product is not germane to the issue of patentability of the method of

using the product or the product itself. The determination of patentability for a method of using a product claim is based on the product itself and the method of using the product and not on the method of production. The method of forming the product is not germane to the issue of patentability of the method of using a product, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art MPEP §2113. Furthermore, there does not appear to be a difference between the prior art method of using and structure and the method of using and structure resulting from the claimed intended use because Sutton discloses natural leather bonded to a polyethylene film (*col. 2, lines 29-35 and col. 3, line 15*).

Regarding Applicant's claim 32, Hofferbert discloses a method of using a composite material (*laminate, col. 1, line 12*) comprising a supporting material in the form of a sheet of roll constituted by one of the following materials: regenerated leather *or* a covering surface layer including a polyethylene film (*thermoplastic layer, i.e. polyethylene, col. 2, lines 29-30 and col. 3, line 15*).

The limitation "the composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases and/or briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements, since the reference discloses the pads are for soles of shoes and pad covers" is deemed to be a statement with regard to the intended use and is not further limiting in so far as the method of using the composite or the structure of the product is concerned. In method of using claims, a claimed intended use must result in a ***difference method of using*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. In

the case, there does not appear to be a difference between the prior art method of using and structure and the method of using and structure resulting from the claimed intended use because Sutton discloses natural leather bonded to a polyethylene film (*col. 2, line 35 and col. 3, line 15*).

The limitation “including the step of forming the material into a shape to produce at least one of the products” is a method limitation. The method of forming the product is not germane to the issue of patentability of the method of using the product or the product itself. The determination of patentability for a method of using a product claim is based on the product itself and the method of using the product and not on the method of production. The method of forming the product is not germane to the issue of patentability of the method of using a product, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art MPEP §2113. Furthermore, there does not appear to be a difference between the prior art method of using and structure and the method of using and structure resulting from the claimed intended use because Sutton discloses natural leather bonded to a polyethylene film (*col. 2, line 35 and col. 3, line 15*).

Regarding Applicant’s claim 33, Hofferbert discloses a method of using a composite material (*laminate, col. 1, line 12*) comprising a supporting material in the form of a sheet of roll constituted by one of the following materials: regenerated leather *or* a covering surface layer including a polyethylene film (*thermoplastic material, i.e. polyethylene, col. 2, lines 29-30 and col. 3, line 15*).

The limitation “the composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases and/or briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements,

since the reference discloses the pads are for soles of shoes and pad covers” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the method of using the composite or the structure of the product is concerned. In method of using claims, a claimed intended use must result in a *difference method of using* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. In the case, there does not appear to be a difference between the prior art method of using and structure and the method of using and structure resulting from the claimed intended use because Sutton discloses natural leather bonded to a polyethylene film (*col. 2, line 35 and col. 3, line 15*).

The limitation “including the step of forming the material into a shape to produce at least one of the products” is a method limitation. The method of forming the product is not germane to the issue of patentability of the method of using the product or the product itself. The determination of patentability for a method of using a product claim is based on the product itself and the method of using the product and not on the method of production. The method of forming the product is not germane to the issue of patentability of the method of using a product, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art MPEP §2113. Furthermore, there does not appear to be a difference between the prior art method of using and structure and the method of using and structure resulting from the claimed intended use because Sutton discloses natural leather bonded to a polyethylene film (*col. 2, line 35 and col. 3, line 15*).

Claim Rejections - 35 USC § 103

13. Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirsch in view of Parrini et al. (U.S. Patent No. 4,162,996).

Hirsch discloses a leather like composite article (*col. 1, lines 8-12*).

Regarding Applicant's claims 31-33, Hirsch discloses a method of using a composite material (*material having at least two layers, title*) comprising a supporting material in the form of a sheet of roll (*strip of leather or simulated leather material, col. 5, lines 31-32*) and a covering layer including a film of polyethylene (*layer of synthetic resin, i.e. polyethylene, col. 5, lines 26-28*), to provide a composite material of only two materials (*figure 1*). The materials being natural or simulated leather (*col. 5, lines 31-32*) and the polyethylene film (*col. 5, lines 26-28*).

The composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases and/or briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements, since the reference discloses a great variety of different articles can be produced with the material such as small leather goods, suitcases, etc. (*col. 4, line 66 through col. 5, line 4*).

Furthermore, the method of using the composite material includes the step of forming the material into a shape to produce at least one of the products, since the reference discloses using the material to make three-dimensional articles by sewing, gluing, welding, and the like (*col. 1, lines 25-28*).

Hirsch fails to disclose the supporting material is constituted by a mixture of a regenerated natural leather material, such material being an essentially natural material.

Parrini disclose a fibrous material useful as leather substituted consisting essentially of leather fibers (*title*). The material is a regenerated natural leather material being essentially natural material, since the reference discloses that the material comprises 30-60% leather fibers (*col. 1, lines 51-59*). The material has a high porosity, dimensional stability to water and abrasion resistance, and good mechanical properties (*col. 1, lines 46-52*).

Hirsch and Parrini are analogous because they both disclose leather-like articles.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Parrini's regenerated natural leather as Hirsch's supporting material in order to reduce cost of the composite. One of ordinary skill in the art would have been motivated to use Parrini's regenerated natural leather because it has a high porosity, dimensional stability to water and abrasion resistance, and good mechanical properties (*Parrini col. 1, lines 46-52*). It is desirable to use a regenerated or synthetic leather because it is cheaper than real leather.

14. Claims 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirsch in view of Parrini as applied above, and further in view of Hara (JP 404130172 A).

Hirsch and Parrini are relied upon as described above.

Hirsch and Parrini fail to disclose that the composite further includes a leather scent to the material.

Hara discloses a leather coat film with a leather perfume layer for better simulation of real leather (*Derwent abstract*).

It would have been obvious to one of ordinary skill in the art to add the leather perfume layer of Hara to the composite material of Hirsch and Parrini. One would be motivated to add the

leather perfume to the composite material of Hirsch and Parrini in order to enhance the simulation of real leather.

The limitation "spraying" is a method limitation and does not determine the patentability of the method of using the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the method of using the product, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because the combination of Hirsch, Parrini, and Hara disclose a composite material with a leather scent.

15. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirsch as applied above, and further in view of Nishimure et al. (3,958,057).

Hirsch is relied upon as described above.

Hirsch fails to disclose a dyestuff layer between the film and the leather.

However, Nishimure discloses a leather-like sheet comprising a pearl substrate layer, a colored layer, and a clear enameled porous sheet (*col. 3, line 54 to col. 4, line 30*). Where the colored layer is a dyestuff layer (*col. 4, lines 5-14*). The leather-like sheet material exhibits the ability to easily perform color matching (*col. 2, lines 1-9*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a dyestuff layer as taught by Nishimure between the leather layer and the film layer in Hirsch. One would be motivated to do so in order enhance or change the color of the layer as desired for its intended use in order to have the ability to easily perform color matching.

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16. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirsch as applied above, and further in view of Hara.

Hirsch is relied upon as described above.

Hirsch fails to disclose adding a leather scent.

However, Hara discloses a leather coat film with a leather perfume layer for better simulation of real leather (*Derwent abstract*).

It would have been obvious to one of ordinary skill in the art to add the leather perfume layer of Hara to Hirsch. One would be motivated to add the leather perfume to the composite material of Hirsch in order to enhance the smell of the real leather.

17. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hofferbert as applied above, and further in view of Nishimure.

Hofferbert is relied upon as described above.

Hofferbert fails to disclose a dyestuff layer between the film and the leather.

However, Nishimure discloses a leather-like sheet comprising a pearl substrate layer, a colored layer, and a clear enameled porous sheet (*col. 3, line 54 to col. 4, line 30*). Where the colored layer is a dyestuff layer (*col. 4, lines 5-14*). The leather-like sheet material exhibits the ability to easily perform color matching (*col. 2, lines 1-9*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a dyestuff layer as taught by Nishimure between the leather layer and the film layer in Hofferbert. One would be motivated to do so in order enhance or change the color of the layer as desired for its intended use in order to have the ability to easily perform color matching.

18. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hofferbert as applied above, and further in view of Hara.

Hofferbert is relied upon as described above.

Hofferbert fails to disclose adding a leather scent.

However, Hara discloses a leather coat film with a leather perfume layer for better simulation of real leather (*Derwent abstract*).

It would have been obvious to one of ordinary skill in the art to add the leather perfume layer of Hara to Hofferbert. One would be motivated to add the leather perfume to the composite material of Hofferbert in order to enhance the smell of the real leather.

19. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sutton as applied above, and further in view of Nishimure.

Sutton is relied upon as described above.

Sutton fails to disclose a dyestuff layer between the film and the leather.

However, Nishimure discloses a leather-like sheet comprising a pearl substrate layer, a colored layer, and a clear enameled porous sheet (*col. 3, line 54 to col. 4, line 30*). Where the colored layer is a dyestuff layer (*col. 4, lines 5-14*). The leather-like sheet material exhibits the ability to easily perform color matching (*col. 2, lines 1-9*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a dyestuff layer as taught by Nishimure between the leather layer and the film layer in Sutton. One would be motivated to do so in order enhance or change the color of the layer as desired for its intended use in order to have the ability to easily perform color matching.

20. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sutton as applied above, and further in view of Hara.

Sutton is relied upon as described above.

Sutton fails to disclose adding a leather scent.

However, Hara discloses a leather coat film with a leather perfume layer for better simulation of real leather (*Derwent abstract*).

It would have been obvious to one of ordinary skill in the art to add the leather perfume layer of Hara to Sutton. One would be motivated to add the leather perfume to the composite material of Sutton in order to enhance the smell of the real leather.

ANSWERS TO APPLICANT'S ARGUMENTS

21. Applicant's arguments in response filed April 22, 2004 regarding the 35 U.S.C. 112 and 103 rejections of record have been considered but are moot since the rejections have been withdrawn.

Conclusion

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Alicia Chevalier', with a stylized, cursive script.

Alicia Chevalier

11/1/04